

REMARKS

The Office Action mailed March 30, 2004 has been reviewed and carefully considered. Reconsideration of the above-identified application, as amended, and in view of the following remarks is respectfully requested. Claims 1-33 are pending, with claims 1, 5, 17, 21, and 25 being the independent claims.

It is noted that the file does not contain a Patent Drawing Review by the Patent Office Draftsperson. In particular, there is no indication that the formal drawings filed on or about November 6, 2002 are acceptable. It is requested that this Review be undertaken and a Review be issued in response to this Amendment.

In the Office Action dated March 30, 2004, the specification was objected to for not including a title on the first page thereof. This objection is not understood. The undersigned's office has filed thousands of applications in precisely the form of this application over at least the past fifteen years and has not received this objection before. It is also respectfully submitted that the first page of the specification as originally filed did have a title thereon. In fact, the filing receipt and the published application reflect this title. Nevertheless, to put this objection to rest, page 1 of the specification has been appropriately amended to include the title appearing on the filing receipt and the published application. Applicants request withdrawal of the objection to the specification.

The Office Action indicates that a reference cited in an Information Disclosure Statement, JP 2000-05210 was not considered on the grounds that an English language abstract or translation was not provided. Submitted herewith is third Information Disclosure Statement attaching a copy of this reference and a translation thereof. Also submitted is a copy of U.S. Patent No. 6,216,227 which is the corresponding U.S. patent to this Japanese patent publication, as can be observed from the serial number of the priority document listed on the Japanese patent publication. An indication that these references have been considered is requested.

Although two Information Disclosure Statements were filed in this case (one on or about June 7, 2001 and the other on or about April 30, 2001), the Examiner did not indicate in the pending Office Action that the references cited in those IDSs were considered by the Examiner. An acknowledgement in the form of an appropriately initialed Form 1449 of such consideration of those references is respectfully requested.

Claims 2, 6, 9, 12, 18, 22, 26, 28, 29 and 31 were objected to for various informalities. With respect to claims 2, 6, 9, 22, 26, and 28, these claims have been amended to clarify that one, or more

than one, of the recited alternatives are claimed, rather than merely one of the alternatives, as apparently noted in the Office Action, page 2. With respect to claim 12, “and” has been changed to --or--, as suggested by the Examiner. With respect to claims 29, 30 and 33, “electronic coupon message” has been changed to --advertising message--, as suggested by the Examiner. With respect to claim 31, “and” has been changed to --or--. Applicants’ request withdrawal of the objections to the claims.

The claims have also been amended to clarify their language.

Applicants have amended the specification and claims to use the singular term, “criterion”, where appropriate. Applicants request withdrawal of the objection to the claims and specification on this “criteria” basis.

Claim 1 was rejected under 35 U.S.C. §112, 2nd paragraph, for usage of “and/or.” Claim 1 has been appropriately amended, and withdrawal of this rejection is requested.

Claims 1-4, and 17-24 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,539, 395 (Buss) in view of U.S. Patent No. 5,724,521 (Dedrick). Claims 1, 17, and 21 are independent.

Independent claim 1 has been amended for clarity and to emphasize the promotional electronic coupon (e-coupon) aspect of the invention. No new matter has been added. The amendments are supported at least by the Figures and the specification at pages 16-19. The language: “User profile” is supported at least by the Abstract and claim 8.

Neither Buss nor Dedrick, either alone or in combination, teaches or suggests all of the limitations in amended claim 1.

Specifically, neither reference teaches or suggests defining a value for the dynamically generated promotion offer of the advertising message based on the number of the at least one selected mobile terminal users that were checked and (known to be) located within a vicinity of a specific location of interest. For example, for ten detected users located near a pizza parlor, each one is dynamically computed to receive ten dollars of promotional offer because the pizza parlor’s budget criterion was \$100 and ten mobile terminal users are present in the vicinity of the pizza parlor.

In Buss, the mobile terminal system merely filters messages which do not apply to the present location of the mobile terminal. The mobile terminal determines where it is located, and can filter out irrelevant messages. Therefore, filtering of messages is essentially the main

disclosure of Buss. In other words, Buss teaches a portable device which is capable of receiving a plurality of location based messages, determining the current location of portable device, and based on that information, selecting a message that is suitable for the current location. So for example, if a pizza parlor sent a promotional message out according to Buss, it would have no way of knowing how many users are actually located in its region and therefore the pizza parlor has no way to dynamically value the promotion or e-coupon. If a \$10 promotion was offered with a \$100 budget, but 50 users received and used the \$10 promotion, there would be a \$400 overcharge on the promotion. Therefore, the claimed limitations provide fundamental differences. As the Examiner acknowledges (page 5 of the Office Action), Buss does not expressly disclose the steps of defining a price for the advertising message based on the number of mobile terminals matching the criterion.

Dedrick is cited as not teaching these claim limitations missing from Buss but as teaching that electronic advertisements are selected based upon “a consumer best-fit profile”. (Office Action, page 6). Dedrick teaches a metering service and charges an appropriately scaled fee to the advertiser depending upon where the end user reading the advertisement falls on a scale rating the end user’s worth to the advertiser. In other words, Dedrick teaches a method and system for charging advertisers based on how well the consumer’s profile matches the advertiser’s defined profile as target customers for the advertisements. Further, the customers are credited for reading the advertiser’s advertising messages. This disclosure in Dedrick has nothing to do with defining a value for the dynamically generated promotion offer of the advertising message based on the number of the selected mobile terminal users located within a vicinity of a specific location of interest, as recited in amended claim 1.

Thus, even if Buss and Dedrick are combined, the limitations of amended claim 1 are not met because neither references actually determines the number of devices present in the relevant area and selects the value of the promotional offer based on this actual number of devices present.

For these reasons, amended independent claim 1 is patentable. Dependent claims 2 to 4 are patentable for the reasons that amended independent claim 1 is patentable.

Independent claims 17 and 21 have been amended in similar fashion to claim 1, and are patentable for the same reasons stated above in regard to claim 1. Dependent claims 18 to 20 and 22 to 24 are patentable because amended independent claims 17 and 21 are patentable.

Independent claims 5 and 25, and dependent claims 6, 7, 8, 9, 15, 16 and 26 to 34 were rejected as anticipated under 35 U.S.C. §102 by Buss.

Claim 5 is not anticipated by Buss because, as discussed above, Buss does not create “an advertising message including content dynamically generated based on a number of mobile terminals selected using the at least one specific criterion to receive the advertising message”, as recited in independent claim 5. Buss will send a message to terminals and discloses no control over the content of the message based upon whether 15 or 100 terminals will be receiving the message. Buss merely filters the messages based on location by, for example, having the terminal filter out irrelevant messages. Therefore, Buss does not differentiate with regard to how many mobile terminals are selected. In fact, as mentioned above, the Examiner acknowledges (Office Action, page 5) that “Buss does not expressly disclose the steps of defining a price for the advertising message based on the number of mobile terminals matching the ... criterion.” Therefore, applicants respectfully note that Buss does not teach the claimed limitations of claim 5 of “an advertising message including content dynamically generated based on a number of mobile terminals selected.” Therefore, Buss does not anticipate amended independent claim 5. Dependent claims 6, 7, 8, 9, 15, and 16 are patentable over Buss for the same reasons that independent claim 5 is patentable over Buss.

The arguments above with respect to claim 5 apply equally to amended independent claim 25. In addition to the limitations discussed above with respect to independent claim 5, independent claim 25 includes another limitation, which is directed to controlling the message content before the message is transmitted to the terminals (underlined below):

“the content of the advertising message being dynamically generated based on a number of mobile terminals selected using the at least one specific criterion to receive the advertising message before being sent to the selected mobile terminals.”

In Buss, filtering occurs after the message is sent, for example, in the mobile unit. For this additional reason, claim 25 is not anticipated by Buss. Dependent claims 26 to 34 are patentable over Buss for the same reasons that independent claim 25 is patentable over Buss.

The remaining dependent claims are patentable because their corresponding base claims are patentable.

Dependent claims 10, 12-14, 29, 31-33 and 34 were rejected as obvious under 35 U.S.C. § 103 over Buss in view of U.S. Patent No. 6,332,127 (Bandera). However, Bandera does not provide the deficiencies in Buss discussed above with respect to independent claims 5 and 25. Namely, Bandera does not teach or suggest an advertising message including content dynamically generated based on a number of mobile terminals selected. For this additional reason, dependent claims 10, 12-14, 29, 31-33 and 34 are patentable over Buss in view of Bandera.

Applicants respectfully submit that this application is in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

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